

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

030158

I hereby certify that this correspondence is being electronically submitted

on 27 February 2007Signature /Andrea L. Mays/Typed or printed name Andrea L. Mays

Application Number

10/665,747

Filed

September 19, 2003

First Named Inventor

Arnold J. Gum

Art Unit

2617

Examiner

Phuoc Huu Doan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 43,721
☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____
/Andrea L. Mays/

Signature

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February 27, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:
Gum, et al.

**For: SYSTEM AND METHOD FOR
INTEGRATION OF WIRELESS
COMPUTER NETWORK IN POSITION
DETERMINING TECHNOLOGY**

Serial No.: 10/665,747

Group Art Unit: 2617

Filed: September 19, 2003

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Phuoc Huu Doan
Examiner

Dear Sir:

Appellants respectfully request review of the final rejection mailed by the Office for the above-referenced application on August 28, 2006 ("the Final Office Action").

A Notice of Appeal is being filed concurrently herewith. This Request for Review is pursued for the reasons presented in the following pages.

Status of Claims

Claims 1-9, 11-32, 34-42, and 44-49 remain pending in this application.

Claims 20-24 and 28 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Publication No. 20030134646 to Forrester (hereinafter Forrester) in view of U.S. Patent Application Publication No. 20020184418 to Blight (hereinafter Blight).

Claims 1-9, 11-13, 15-18, 25-26, and 29-32, 34-42, and 44-49 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Forrester in view of Blight and further in view of U.S. Patent Application Publication No. 20030046158 to Kratky (hereinafter Kratky)

Claim 14 is rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Forrester, Blight, and Kratky in further view of U.S. Patent Publication No. 20040030601 to Pond (hereinafter Pond). Claims 19 and 27 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Forrester, Blight, and Kratky in further view of U.S. Patent Publication No. 20030118015 to Gunnarsson (hereinafter Gunnarsson).

The Examiner Fails to Establish a Prima Facie Case of Obviousness

Applicant contends that the references fail to teach, either alone or in combination, all of the claimed features of rejected claims 1-9, 11-32, 34-42, and 44-49. Additionally, there is no motivation to combine or otherwise modify the teachings of Forrester with Blight and Kratky in a manner that would teach the claimed invention. Thus, because there is no *prima facie* case for obviousness, the claims are believed to be allowable over the cited references.

The Cited References Fail to Teach or Suggest All Claim Limitations

Applicant provides an analysis of claims 20-28 in the Response After Final, dated October 30, 2006, at pages 2-3, in the Response After Final, dated August 3, 2006, at pages 5-6, and in the Amendment, dated May 9, 2006, at pages 10-11. In each of Applicant's responses, Applicant demonstrates that Forrester and Blight, whether alone or in combination, fail to teach or suggest the feature in claim 20 of "a position determining entity to determine the position of the mobile communication device based on the data received from the GPS satellites, *if available with an acceptable error range*, the communication signals from the base transceiver station, *if*

available with an acceptable error range, and the data received from the network wireless access point.” (*emphasis added*).

The Examiner fails to address the failings of Forrester and Blight with regard to the described feature. Instead, the Examiner, in the Advisory Action, refers to Applicant's Specification at pages 10-12 and pages 14-15, and states that “[t]he prior art has been applied based on Applicant's specification interpreted to claim language.” *See, Advisory Action*, dated November 20, 2006, at page 2.

However, the Examiner cite or discuss any portion of Forrester or Blight that describes the claimed “a position determining entity to determine the position of the mobile communication device based on the data received from the GPS satellites, *if available with an acceptable error range*, the communication signals from the base transceiver station, *if available with an acceptable error range*.” Applicant's Specification, at FIG. 6-7 and paragraphs [0063] - [0067], clearly provides an example of a system using an error range to make a conditional determination of whether a position determination was satisfactory.

The Examiner's citation in the Advisory Action to pages from Applicant's own Specification fails to provide reasoning that overcomes the failure of the cited references to teach or suggest the claimed features. Indeed, throughout prosecution, the Examiner fails to identify the language highlighted above in the quoted portion of the claim in any of the rejections, and instead, rejects the claims without reference to the highlighted language.

The Examiner fails to establish a prima facie case of obviousness because the cited references fail to teach or suggest every claimed feature.

There is No Motivation to Combine the Cited References

Applicant detailed, in the Response After Final, dated October 30, 2006, at pages 3-5, address the alleged motivation to combine Forrester with Blight presented in the final Office Action, dated August 28, 2006.

The Examiner, in the Advisory Action, dated November 20, 2006 does not address the shortcomings of the prior motivation to combine, but instead, appears to present a new motivation to combine Forrester with Blight. *See, Advisory Action*, at pages 3-4.

However, there is nothing in the Examiner's new motivation to combine the teachings of Forrester with Blight that would motivate one to perform the selective combination needed to

describe portions of the claimed inventions. Indeed, there is nothing in the motivation provided by the Examiner in the Advisory Action that would motivate one to include a Position Determining Entity with the system of Blight.

Furthermore, the Examiner provides no motivation to combine Kratky with Forrester and Blight. In the final Office Action, dated August 28, 2006, the Examiner concedes that Forrester and Blight fail to teach or suggest display of non-position information, as claimed in independent claims 1, 29, and 40. The Examiner contends that Kratky teaches the claimed feature and argues that it would be obvious to combine the particular feature from Kratky "in order to display the advertiser's location." *Office Action*, dated August 28, 2006, at page 7.

However, neither Forrester nor Blight describes nor mentions an advertiser. Indeed, neither Forrester nor Blight even uses the term "advertiser" in the applications. Thus, the motivation presented by the Examiner fails to provide a sufficient basis for combining the references in the manner argued by the Examiner. The motivation argued by the Examiner has no bearing on the descriptions in either Forrester or Blight, and thus could not have been the basis for one of ordinary skill in the art to seek out and combine the specific feature that the Examiner selectively extracts from Kratky.

Therefore, the prima facie case of obviousness cannot be maintained, because the Examiner fails to provide a reasonable motivation to combine the references in a manner that would result in Applicant's claimed invention.

Discussion of Dependent Claims

Claims 2-9, 11-19, 21-28, 30-32, 34-39, 41-42, and 44-49 depend, either directly or indirectly, from one of claims 1, 20, 29, or 40 and are believed to be allowable at least for the reason that they depend from an allowable base claim.

Additionally, Applicant provided in the Amendment dated May 9, 2006, distinct arguments and basis for patentability of dependent claims 16, 18, 37, 39, 47, and 49. Applicant's arguments were presented as illustrative of the patentable features of the dependent claims, and were not intended to be exhaustive of all features included in the dependent claims.

As provided by Applicant in the Amendment dated May 9, 2006, at pages 11-12, the Examiner argues that the claimed features are inherent in the cited references, but it is clear that

the claimed features are not necessarily present, as required in a case of inherency. The Examiner fails to address Applicant's arguments regarding the dependent claims in the subsequent Office Action, but merely dismisses them. However, Applicant believes that at least claims 16, 18, 37, 39, 47, and 49 are patentable for the reasons argued in the May 9, 2006 correspondence, distinct from any other reasons for patentability.

CONCLUSION

Applicant respectfully requests reconsideration and allowance of claims 1-9, 11-32, 34-42, and 44-49 in light of the arguments summarized above and supplied in the correspondence presented in response to prior Office Actions. Applicant respectfully believes that a *prima facie* case of obviousness has not been established, nor can the rejections of the claims be maintained.

Applicants therefore respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

Dated: February 27, 2007

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